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09/556,143	04/21/2000	Ronald A. Schachar	PRES06-00163	6710

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EXAMINER

SHAY, DAVID M

ART UNIT PAPER NUMBER

3739

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/556,143
Filing Date: April 21, 2000
Appellant (s): SCHACHAR, RONALD A.

William A. Munck
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 6, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claim*

Disagreement With Statement of Status Of Claims

The statement of the status of the claims contained in the Brief is incorrect. The current status of the claims is as follows:

Claims Allowed:

Claims 40-44 are allowed as set forth below.

Claims Withdrawn:

Claims 45-48 stand withdrawn from further consideration.

Claims on Appeal:

This appeal involves claims 31-39.

(4) *Status of Amendments After Final*

Agreement with appellant's statement of the status of amendments after final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

Agreement with the summary of the invention

The summary of the invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The rejection under 35 U.S.C. 112, first paragraph has been withdrawn in view of the statement of incorporation by reference of U.S. Patent 5,354,331 as set forth in the specification as originally filed at page 9, lines 4-5.

The rejection under 35 U.S.C. 102 of claims 40-44 has been withdrawn as set forth below.

Claims 31-39 stand rejected under 35 U.S.C. 102 (b) as clearly anticipated by Fankhauser

(7) Grouping of Claims

The rejection of claims 31-39 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Number	Name	Date
4,391,275	Fankhauser et al	July 5, 1983

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The examiner has reviewed applicant's arguments and located incorporation by reference on page 9 of the original specification which does provide support for the use of a laser as claimed. Thus, the enablement rejection has been withdrawn, as the use of a laser is enabled thereby. However, the substitute specification includes matter not disclosed in Patent Number 5,354,331 and as such entry thereof is still denied. Further the examiner has reviewed the Fankhauser et al reference. At column 6, lines 3-13 Fankhauser mentions that as a result of the treatment the wall of the canal of Schlemm is destroyed while "the collages fibers of the sclerotic have practically not suffered". In view of this disclosure, the method of Fankhauser et al cannot fairly be said to "weaken the sclera of the eye" and thus claims 40-44 are allowable over Fankhauser et al.

The following rejection is still applied:

Claims 31-39 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fankhauser et al.

(11) Response to Argument

Applicant argues that Fankhauser et al do not teach the claimed device in that the laser is operable to weaken the sclera to thereby increase the effective working distance of the auxiliary muscle of the eye.

The examiner notes that the Fankhauser et al laser (an Nd:YAG laser – see column 5, lines 44-46, wherein Nd is the chemical symbol for Neodymium) is clearly operable to (i.e. can be operated to) weaken the sclera for example by moving the patient a fraction of a millimeter closer to the laser. Thus causing ablation or destruction of the sclera. As explained in the

Abstract, the density of radiated energy causes ionization of the propagation medium (see Abstract, lines 10 and 11). Thus the density will cause ionization and tissue ablation in the sclera if the beam is directed thereto. This removal of tissue will inherently leave the remaining material weaker than the undamaged tissue was. Similarly, the laser is also operable to weaken the sclera by abrading, incising, incising at select angles, and partially decomposing collage fibers, using knowledge of one having ordinary skill in the art at the time of the invention, since applicant provides no details as to how to effect these various alternatives. This weakening will inherently allow the weaker material to expand due to the internal pressure of the eye (see column 1, lines 15-25 and 66-68 of Fankhauser et al for a discussion of the internal pressure of the eye).

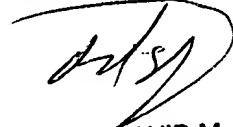
(12) Conclusion

It is the examiner's firm opinion that the appealed claims are not patentable for the reasons argued above. Appellant has presented no convincing argument as to why the rejection set forth above is not proper. Therefore, it is respectfully submitted that the Final Rejection be affirmed.

Application/Control Number: 09/556,143
Art Unit: 3739

Page 6

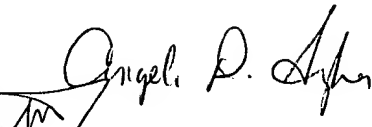
Respectfully submitted,



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January 25, 2004

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